

**REMARKS**

Upon entry of the present amendment, claims 1-2, 4, 6, 8-15 and 17 are pending in the above-referenced patent application and are currently under examination. Claim 10 is allowed. Claims 1 and 13 have been amended. Claims 3, 5, 7 and 16 have been canceled. Claim 17 has been added. Reconsideration of the application is respectfully requested.

Claim 1 has been amended to incorporate the limitations of canceled claims 3, 5 and 7 in order to clarify the scope of the compounds of the present invention. Support for the amendment based on claim 3 can be found in claim 3 as filed, as well as paragraphs [0031] through [0033] (pp. 8-9) of the specification. Support for the amendment based on claim 5 can be found in claim 5 as filed, as well as paragraph [0034] (p. 9) of the specification. Support for amendment based on claim 7 can be found in claim 7 as filed, as well as paragraphs [0035] through [0037] (pp. 9-10), paragraph [0044] (p. 12-13) and Table A (paragraph [0046], pp. 13-20) of the specification.

Claim 13 has been amended to specify Gram-positive bacteria. Support for this amendment can be found in paragraph [0049] (pp. 22) of the specification.

New claim 17 finds support in claims 3, 5 and 7 as filed, as well as paragraphs [0033] through [0034] (pp. 8-9) of the specification.

Additional support for the amendments to the claims and the new claims can be found in the claims as filed, as well as throughout the specification.

Applicants believe the claim amendments and new claim add no new matter to the claims.

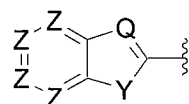
The claims are rejected to in various combinations under 35 U.S.C. § 112, 1st paragraph, 35 U.S.C § 112, 2d paragraph and 35 U.S.C. § 101. Each of these rejections is addressed below in the order set forth by the Examiner.

# **I. REJECTIONS UNDER 35 U.S.C. § 112, 1st, WRITTEN DESCRIPTION**

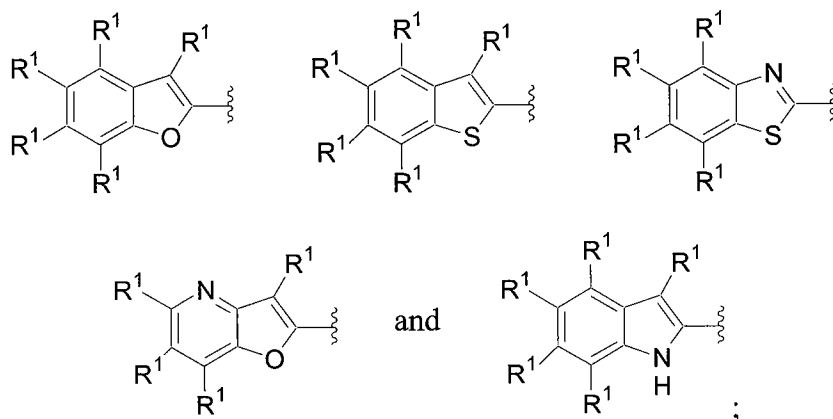
Claims 2, 3, 7, 9 and 12 have been rejected under 35 USC § 112, first paragraph, as allegedly failing to comply with the written description requirement. Applicants respectfully traverse the rejection in view of the comments below.

The test for written description is whether the specification describes “the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention.” See, *e.g.*, *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319, 66 USPQ2d 1429, 1438 (Fed. Cir. 2003); *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116-17. “The subject matter of the claim need not be described literally (i.e., using the same terms or in *haec verba*) in order for the disclosure to satisfy the description requirement.” (MPEP §§ 2163, 2163.02).

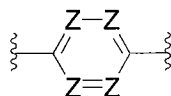
Applicants note that claim 1 has been amended to the scope of claims 3, 5 and 7, such that the moiety



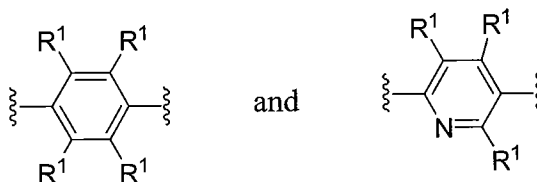
is limited to:



the moiety



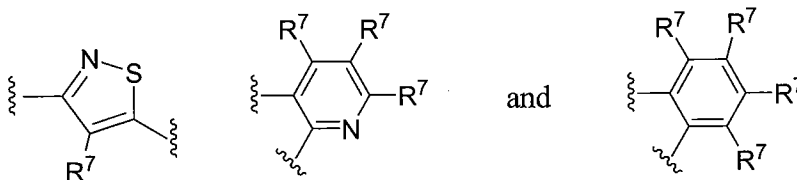
is limited to:



and the moiety



is limited to:



Applicants note that the Examiner recognized that the definitions described above, now incorporated into amended claim 1, are supported by the compounds of the specification as filed (p. 5, Office Action).

As recognized by the Examiner, the scope of amended claim 1 is adequately supported by the specification as filed. Thus, claims 1, 2, 9 and 12 comply with the written description requirement under 35 U.S.C. § 112, 1st paragraph. Accordingly, Applicants respectfully request that the Examiner withdraw this aspect of the rejection.

## II. REJECTIONS UNDER 35 U.S.C. § 112, 1st, ENABLEMENT

Claims 13-15 have been rejected under 35 USC § 112, first paragraph, as allegedly failing to comply with the enablement requirement. Applicants respectfully traverse the rejection.

The test for enablement is whether the experimentation needed to practice the invention is undue or unreasonable (*Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916)) such that “the disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention” (MPEP § 2164.01).

The Examiner has rejected claims 13-15 as allegedly not providing enablement for every bacterial infection in a mammal. Without agreeing with the Examiner, Applicants have amended the scope of claims 13-15 to “gram-positive bacterial infection.” Applicants note that the Examiner stated that the instant specification was enabling of such claim scope (p. 7, Office Action). Thus, Applicants submit that claims 13-15 are enabled under 35 U.S.C. § 112, 1st paragraph. Accordingly, Applicants respectfully request that the Examiner withdraw this aspect of the rejection.

### **III. REJECTIONS UNDER 35 U.S.C. § 112, 2d/ 35 U.S.C. § 101**

Claim 16 has been rejected under 35 USC § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. Claim 16 has also been rejected under 35 U.S.C. § 101, as being drawn to an improper process claim. Applicants respectfully traverse the rejection in view of the comments below.

Applicants note that claim 16 has been canceled. Accordingly, Applicants respectfully note that this aspect of the rejection is now moot.

Appl. No. 10/523,422  
Amdt. dated June 13, 2008  
Reply to Office Action of January 14, 2008

PATENT

**CONCLUSION**

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,



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